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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,044	11/19/2003	Robert Steven Puskas	60020240-0025	3512
26263	7590	07/17/2006	EXAMINER	
SONNENSCHEIN NATH & ROSENTHAL LLP P.O. BOX 061080 WACKER DRIVE STATION, SEARS TOWER CHICAGO, IL 60606-1080				LU, FRANK WEI MIN
ART UNIT		PAPER NUMBER		
		1634		

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/720,044	PUSKAS, ROBERT STEVEN	

  

<b>Examiner</b>	<b>Art Unit</b>	
Frank W. Lu	1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_ is/are objected to.
- 8) Claim(s) 1-57 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. ____ .   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: ____ .                                   |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Since there are two sets of claims 32 and 33 in the claims filed on November 19, 2003, the second set of claims 32 and 33 now are renamed as claims 34 and 35 and the pending claims now are claims 1-57. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 21-33, drawn to a method for detecting a target nucleic acid molecule or target nucleic acid molecular complex, classified in class 435, subclass 6.
- II. Claims 10-20 and 34-51, drawn to a method for detecting a target nucleic acid molecule or target nucleic acid molecular complex (claims 10-20 and 34-42) and a method for determining the number of probes interacting with a target (claims 43-49), classified in class 435, subclass 6.
- III. Claims 52-57, drawn to a method for detecting a target nucleic acid molecule or target nucleic acid molecular complex, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:  
Groups I and II are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group I such as an interrogation volume in claim 1 is not required for Group II while the search required for Group II such as detecting the velocity of the probes in contact with molecule or molecular complex in claim 10 is not required for Group I.

Art Unit: 1634

Groups I and III are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group III such as the velocity of the molecular probes-target hybrids matches the expected velocity for such a complex in a transport tube in claim 52 is not required for Group I.

Groups II and III are distinct and independent inventions in that they are directed to methods which comprise different method steps. As a result, different and distinct searches will have to be performed. For example, the search required for Group II such as detecting the velocity of the probes in contact with molecule or molecular complex in claim 10 is not required for Group III while the search required for Group III such as luminescent or fluorescent intensity per detection time unit of each probe in claim 52 is not required for Group II.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3.     Group I contains claims directed to the following patentably distinct species:
  - (1)    each probe in contact with the molecule or molecular complex possesses substantially equal fluorescence intensity or parameter values (claims 2 and 24)
  - (2)    each probe in contact with the molecule or molecular complex has a fluorescence intensity distinguishable from another probe in contact with the same molecule or molecular complex (claims 3 and 25)

The species are independent or distinct because these species have different fluorescent properties.

Art Unit: 1634

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 1, 4-9, 21-23, and 26-33.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. Group I further contains claims directed to the following patentably distinct species:
  - (3) detection of probes in contact with the molecule or molecular complex is provided by a single fluorescence detector (claims 7 and 29)
  - (4) each probe in contact with the molecule or molecular complex has a fluorescence intensity distinguishable from another probe in contact with the same molecule or molecular complex (claims 8 and 30)

The species are independent or distinct because these species are directed to different detection methods.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 1-7, 21-28, 31, and 32.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. Group II contains claims directed to the following patentably distinct species:

- (5) each probe in contact with the molecule or molecular complex possesses substantially equal fluorescence intensity or parameter values (claims 13 and 37)
- (6) each probe in contact with the molecule or molecular complex has a fluorescence intensity distinguishable from another probe in contact with the same molecule or molecular complex (claims 14 and 38)

The species are independent or distinct because these species have different fluorescent properties.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 10-12, 34-36, and 39-51.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

Art Unit: 1634

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

6. Group II further contains claims directed to the following patentably distinct species:

- (7) detection of probes in contact with the molecule or molecular complex is provided by a single fluorescence detector (claims 18 and 42)
- (8) each probe in contact with the molecule or molecular complex has a fluorescence intensity distinguishable from another probe in contact with the same molecule or molecular complex (claims 19 and 43)

The species are independent or distinct because these species are directed to different detection methods.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, generic claims are claims 10-17, 20, 34-41, and 44-51.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

7. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

July 10, 2006



FRANK LU  
PRIMARY EXAMINER